



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Friend et al.

Attorney Docket No. 100647/03950

Serial No.: 09/882,464

Examiner: Not assigned

Filed: June 14, 2001

Group Art Unit: Not assigned

For: MULTILAYERED POLYMERIC STRUCTURE

CERTIFICATE OF MAILING

Commissioner for Patents
Washington, D.C. 20231
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I hereby certify that this correspondence is being deposited on 1/3/02
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Sir:

Signature: _____

John W. Kung, Reg. No. 44,199

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TC 1700

PETITION TO PROCEED WITHOUT INVENTOR PARTICIPATION UNDER 37 CFR 1.47

Applicants hereby petition the Commissioner for permission to prosecute the above-referenced application without the participation of inventor Stephen O. Friend, who has stated unequivocally his intention not to abide by his contractual obligations to assist in the prosecution of the above-referenced application and who persists in his unwillingness to cooperate.

This Petition is submitted in connection with the above-identified application in accordance with 37 CFR 1.47(a), which provides that:

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(h) and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

REMARKS

As set forth in detail in the accompanying Statements of John W. Kung, Esq. re: Refusal of Stephen O. Friend to Participate, attached as Exhibit A, Kramer Levin Naftalis & Frankel LLP (“Kramer Levin”), attorneys for the Applicants, have made numerous attempts to contact Mr. Stephen O. Friend to sign the declaration and power of attorney for the above-named application

which names Mr. Friend as a joint inventor. Hyperion Catalysis International, Inc. is the Assignee of the above-identified application.

Mr. Friend has repeatedly refused to sign the declaration and power of attorney or otherwise cooperate in any way for any patent application naming him as a joint inventor and to be assigned to Hyperion Catalysis International, Inc.

On June 15, 2001, Kramer Levin filed the above-named application with the United States Patent and Trademark Office. Subsequently, Kramer Levin sent a copy of a Declaration and Power of Attorney via certified mail to Mr. Friend's home at 63 Surrey Lane, Boxwood MA 01921 on November 12, 2001.

On November 15, 2001, Mr. John Kung, an attorney handling patent applications at Kramer Levin telephoned the Friend household at (978) 887-0399 at 5:44 PM EST and left a message on their answering machine asking Mr. Friend if he had received the Declaration and Power of Attorney and if he would return Mr. Kung's phone call. Mr. Kung never received a response from Mr. Friend.

On November 28, 2001, Mr. Kung called the Friend household at (978) 887-0399 at 5:50 PM EST and spoke to a woman who identified herself as Mr. Friend's wife. She told him that Mr. Friend had been out of the country but was to return home on November 29, 2001. She also confirmed that she had received the Declaration and Power of Attorney and that she would give the Declaration and Power of Attorney to Mr. Friend.

On December 5, 2001, Mr. Kung called the Friend household at (978) 887-0399 and left another message on their answering machine asking Mr. Friend to return his phone call. Mr. Kung never received a response from Mr. Friend.

On December 12, 2001, Mr. Kung called the Friend household at (978) 887-0399 and spoke to Mrs. Friend who mentioned that Mr. Friend was once again out of the country but was returning to the United States on December 17, 2001.

On December 18, 2001, Mr. Kung called the Friend household at (978) 887-0399 at 5:20 PM EST and once again spoke to Mrs. Friend who said that Mr. Friend indeed had been getting Mr. Kung's messages and that Mr. Friend was in possession of the Declaration and the Power of Attorney.

Insofar as Mr. Friend persists in his unwillingness to cooperate for any application naming him as a joint inventor and owned by Hyperion Catalysis International, Applicants request permission under 37 CFR 1.47, 35 U.S.C. § 116 and MPEP 409.03 to pursue the affected patent applications without his assistance. Based on the foregoing facts and circumstances, Applicants believe that Mr. Friend's conduct constitutes a refusal to sign any declaration or power of attorney for the above-identified application, after a *bona fide* presentation of the application papers under MPEP 409.03(d), and request permission to proceed under 37 CFR 1.47 with the aforementioned application.

In accordance with 37 CFR 1.47, the last known address of the nonsigning inventor is 63 Surrey Lane, Boxwood, MA 01921.

Applicants trust that this Petition and the attached Exhibit establish to the satisfaction of the Commissioner that the nonsigning inventor, Stephen O. Friend, does not intend to participate in the prosecution of the above-referenced application, and therefore that the Applicants of the above-referenced application should be permitted to prosecute the application in the absence of Stephen O. Friend.

Applicants hereby authorize the Commissioner to charge the amount of \$130.00 in payment of the fee under 37 CFR 1.17(h) believed to be necessary in connection with the filing of this Petition to Deposit Account No. 50-0540. In addition, the Commissioner is hereby authorized to charge such fee(s) or credit any overpayment(s) as deemed necessary for the entry of this Petition to Deposit Account No. 50-0540. A second copy of this Petition is provided herewith.

If a telephone interview would be of assistance in advancing the prosecution of this application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Dated: 1/3/02

Respectfully submitted,

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